

REMARKS/ARGUMENTS

Reconsideration and allowance of all claims remaining of record as presently amended is respectfully requested. By this amendment claim 13 is amended to include the limitation that detailed information and identifier images are displayed in different display areas. In addition, dependent claims 39 and 40 are newly added.

The rejection of claims 2-7, 9-22 and 24-30 under 35 U.S.C. §103 as allegedly being unpatentable over Brown et al. (U.S. Patent No. 6,356,908), Carpenter et al. (U.S. Patent No. 5,754,174) and Edelman (U.S. Patent No. 5,680,563) is respectfully traversed.

Applicants respectfully contend that it would not have been obvious at the time of Applicants' invention to "modify the image information processing device taught by Brown to include the change in display order taught by Carpenter". Applicants also respectfully contend that it would not have been obvious at the time of Applicants' invention to "modify the image information processing device taught by Brown to include making filtered items gray out and non-selectable taught by Edelman" as alleged in the Office Action. There is no teaching or suggestion in either Brown or Carpenter of the desirability to implement such modifications. When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See *In re Geiger*, 815 F. 2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

The Office Action alleges that the modification of Brown by the teachings of Carpenter would be obvious "with the motivation being to present information and images in different display orders". Applicant strongly contends that this rationale is little more than the application of hindsight. There is no teaching or suggestion in either Brown or Carpenter of the desirability to implement such a modification. It is well established that even if the Examiner is of the view

that the prior art could conceivably be modified to somehow result in the claimed invention, such a modification would not be obvious within the meaning of 35 USC §103 unless the prior art suggested the desirability of such a modification. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984).

Likewise, the Office Action also alleges that the modification of Brown by the teachings of Edelman would be obvious "with the motivation being to enhance visual representation of filtered and unfiltered items". Applicant strongly contends that this rationale is also little more than the application of hindsight. There is simply no teaching or suggestion in either Brown or Edelman of the desirability to implement such a modification.

The Office Action improperly relies on hindsight reconstruction of the claimed invention based on the teachings of the instant application in reaching its obviousness determination. "To imbue one of ordinary skill in the art with knowledge of the invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." See *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1543, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Only in view of the teachings of the instant application could the rejections possibly be maintained.


Applicant contends that no references have been cited that provide a factual basis for the conclusion of what is alleged in the Office Action as being obvious, i.e., no teaching has been provided that suggests the obviousness of modifying Brown's method of presenting content from a web page in a database to perform the setting of display order of detailed information and identifier images, and including the displaying of selected extracted information in a manner that is more visually recognizable than non-select information, as set forth in Applicants' claims.

Thus, the Office Action sets forth a conclusion of obviousness, not a reason supporting the alleged obviousness of the present invention. It is axiomatic that the PTO has a burden under §103 to establish a prima facie case of obviousness. See In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

In view of the foregoing remarks and amendments, Applicants submit that all claims now remaining in the present application are in condition for allowance and earnestly solicit a Notice to that effect. The Examiner is invited to contact the undersigned at the telephone number listed below if any further matter remains outstanding.

Respectfully submitted,

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